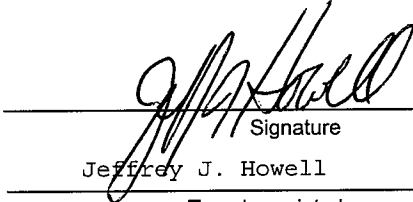


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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 118990-025	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____		Application Number 10/516,534	Filed December 2, 2004
		First Named Inventor Hahn, et al.	
		Art Unit 2618	Examiner S. Nguyen
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <div style="display: flex; justify-content: space-between; align-items: flex-start; margin-top: 20px;"><div style="width: 45%;"><p>I am the</p><p><input type="checkbox"/> applicant/inventor.</p><p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p><p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>46,402</u></p><p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p></div><div style="width: 50%; text-align: center;"> _____ Signature Jeffrey J. Howell _____ Typed or printed name _____ 202-955-6832 _____ Telephone number _____ September 26, 2007 _____ Date</div></div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Hahn et al.
Appl. No.: 10/516,534
Conf. No.: 4504
Filed: December 2, 2004
Title: METHOD AND DEVICE FOR AUTHENTICATING A SUBSCRIBER FOR
UTILIZING IN WIRELESS LAN (WLAN)
Art Unit: 2618
Examiner: S. Nguyen
Docket No.: 118990-025

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF

Sir:

In reply to the Final Office Action dated June 27, 2007 and, Applicant hereby submits this Pre-Appeal Brief along with the attached Notice of Appeal.

REMARKS

I. REJECTIONS OF CLAIMS 1-7, 10-16, 18, 19, 21 and 23-26 UNDER 35 USC 102(e) AS ANTICIPATED BY DYNARSKI ET AL., NAKAJIMA AND/OR SAUNDERS ET AL. ARE IMPROPER

The claims of this application generally cover a device and method that can efficiently authenticate a subscriber of a wireless LAN (WLAN) who is also a mobile radio network subscriber, while utilizing services in a mobile radio network (e.g. GSM or UMTS). One of ordinary skill in the art would understand that an IP multimedia system is used to authenticate a subscriber of the mobile radio network¹. One aspect of this invention is that an IP multimedia subsystem is used for authenticating the subscriber within the WLAN. An IP multimedia subsystem is traditionally used for authenticating the subscriber within a GSM or UMTS network, not authenticate a subscriber of the mobile radio network.

¹ compare <<http://www.3gpp.org/ftp/Specs/html-info/23228.htm>, V1.4.0

In order to authenticate a subscriber of the mobile radio network, an IP-address that is attributed by the WLAN to the subscriber is used for authenticating the subscriber by means of SIP registration. An example of an embodiment is the use in airports, where providers of mobile telephony additionally maintain WLAN-hotspots in order to provide WLAN access to their customers. A considerable advantage is that no separate authentication server is required for the WLAN and additionally no separate authentication elements (e.g. secret keys) are required in the subscribers end device. In addition, registering the subscriber with SIP at the IP multimedia subsystem provides high security against unlawful use. Further advantages can include a unified billing process (and only one bill for the customer). Such advantages and embodiments are meant to help understand the full scope of the claims and are not meant to limit the claims to these specific embodiments and/or advantages.

It is apparent in the office action that the examiner misinterprets the term "IP multimedia subsystem". One of ordinary skill in the art would understand that within the field of mobile telecommunication the term "IP multimedia subsystem" means an architectural framework, for example, the framework originally designed by the 3rd Generation Partnership Project (3GPP)². Beyond a number of other tasks, an IP multimedia subsystem includes secure and flexible authentication procedures for callers (compare e.g. Annex E).

The document 3GPP TS 23.228 V1.4.0 provides an example of technical specifications of an "IP multimedia subsystem". The fact that the document bears as title "IP multimedia subsystem – stage 2" and the fact that 3gpp is one of the leading international cooperation of standard bodies in mobile telecommunication is further evidence that one of ordinary skill in the art would understand that an IP multimedia subsystem would include an architectural framework exemplified in this document.³

² See also, Wikipedia - <http://en.wikipedia.org/wiki/IP_Multimedia_Subsystem> ("The IP Multimedia Subsystem (IMS) is an architectural framework for delivering internet protocol (IP) multimedia to mobile users. It was originally designed by the wireless standards body 3rd Generation Partnership Project (3GPP), and is part of the vision for evolving mobile networks beyond GSM. [...]")

³ The definition of an IP multimedia subsystem being a framework defined by 3gpp is also found in wikipedia <http://en.wikipedia.org/wiki/IP_Multimedia_Subsystem>. Wikipedia additionally references the technical specifications of the 3gpp website.

None of the cited prior art discloses or renders obvious all of the elements of the independent claims. Specifically, none of the cited prior art discloses or renders obvious (1) "authenticating a subscriber for utilizing services in a wireless LAN while using an IP multimedia subsystem of a mobile radio network", (2) "receiving an IP address from the wireless LAN, after which the subscriber receiving the IP address is authenticated to the IP multimedia subsystem while giving the IP address, by means of SIP registration", and (3) "informing an element of the wireless LAN of the result of the authentication of the subscriber with regard to the IP multimedia subsystem". In fact, none of the cited prior art discloses any IP multimedia subsystem and or any SIP registration.

Dynarski discloses a method for finding a mobile wireless communications device when an Internet Protocol (IP) packet from a remote user is sent to the device over an IP network (see abstract Dynarski). According to the office action, an IP multimedia subsystem is disclosed in the abstract, in fig. 1, in column 3 lines 50-62, and in column 5 lines 20 to 35. Applicant respectfully disagrees. An IP multimedia subsystem (as known to one of ordinary skill, as outlined above) is not disclosed explicitly or implicitly in these passages, nor in the whole document.

In addition, Dynarski also fails to disclose a WLAN. The wireless network described by Dynarski is not sufficiently specified to be considered a WLAN: In the office action Dynarski's "home agent" is considered to be equal or to constitute a WLAN. Applicant is unsure how such a leap was made, but we assume that it comes from the abstract, which states "The method comprises the steps of receiving the IP packet at a home agent associated with a wireless communications network." A wireless communications network can be any kind of network. In contrast a WLAN. Considering Dynarski's figure 1, it becomes clear that the Dynarski network is connected to the radio tower (via several network nodes) and is not a WLAN.

Furthermore, the claims of this application cover two types of mobile networks: (1) a WLAN and (2) a mobile radio network that uses an IP multimedia subsystem. In contrast, the embodiments of Dynarski only involve one kind of network, which is only vaguely specified; however, the office action seems to take the position that Dynarski's one and only network, on the one hand performs the function of the mobile radio network, and on the other hand also performs the function of the WLAN. In contrast, our independent claims clearly point out, that

two kinds of mobile networks are involved, namely a WLAN and a mobile radio network that is managed by an IP multimedia subsystem.

Nakajima discloses a method according to which a service terminal sends an ID or an IP address particular to the service terminal to a mobile terminal. The mobile terminal notifies the ID or the IP address, and a telephone number /a serial number of the service terminal to the subscriber system. The subscriber system then performs authentication in response to the notification, and when authentication is recognized, it notifies a service gateway of the use of the IP address notified by the mobile terminal. The service gateway interconnects the serviced terminal and the internet. The subscriber system monitors the interconnection between the mobile terminal and the internet charge service fee. Nakajima does so, to eliminate a necessity for service providers to employ a user authentication process both when providing a network service, and when charging a fee for the service. However, Nakajima fails to disclose an IP multimedia subsystem and SIP registration of the subscriber. None of the passages cited in the office action (abstract, figures 1-6, paragraphs 5-12, 27, 36-40) explicitly or implicitly disclose an IP multimedia subsystem or SIP registration.

Saunders discloses a method in order to securely access to applications such as intranet access and corporate e-mail systems from mobile terminals such as cellular telephones and PDAs using Wireless Application Protocol. Saunders therefore has a completely different objective than this application. It is not the goal of the application only to securely access applications on one network, but basically to securely access at least two different networks, namely a WLAN and a mobile radio network. In addition, the claims are not drawn to WAP, but to WLAN-communication and mobile telephony. In addition, since having a different objective than this application, Saunders fails to disclose an IP multimedia subsystem, a WLAN, and SIP registration. Neither the passages cited by the examiner (abstract, figures 1-4, paragraphs 46-51), nor the rest of the documents gives any hint about WLANs, SIP, or an IP multimedia subsystem.

Applicant therefore submits that independent claims 1 and 23 and their respective dependent claims are allowable over the cited prior art.

II. REJECTIONS OF CLAIMS 8, 9, 17, 20 AND 22 UNDER 35 USC 103(A) AS UNPATENTABLE OVER SAUNDERS AND EJZAK, MAO OR CHRISTOFFEL ET AL. ARE IMPROPER

Applicant submits that Ejzak, Mao and/or Christoffel fail to overcome the deficiencies discussed above.

The object of Ejzak is to provide a communication system having features and services that can be utilized by both circuit-switched and packet-switched mobile units. In contrast, as already mentioned above, the object of our invention is different, to efficiently authenticate a subscriber of a wireless LAN (WLAN) who is also a mobile radio network subscriber. Ejzak fails to disclose a WLAN. Additionally, although Ejzak discloses an IP multimedia subsystem, it fails to disclose authentication of the subscriber by the IP multimedia subsystem. Ejzak is an SGSN, which is responsible for authentication (compare Ejzak paragraph [0026] and figure 1; In figure 1 the reference number of the SGSN is 132, while the reference number of the IMS is 141).

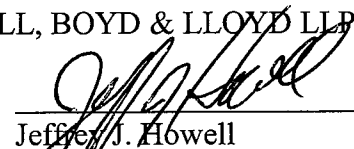
The object of Mao is to provide a method of exchanging data between data network users, which can overcome above disadvantages to connect network users in private networks (e.g., intranet) and new networks (e.g., 3 G) to the public network, in order to achieve communication between private network users, or between private network users and public network users (comp. MAO, Paragraph [0020]). Mao therefore mainly targets fixnet applications and again, this is a totally different object than this application. MAO fails to disclose an IP multimedia subsystem, a WLAN, SIP registration of a user.

The Commissioner is hereby authorized to charge deposit account 02-1818 for any fees which are due and owing.

Respectfully submitted,

BELL, BOYD & LLOYD LLP

BY


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Customer No. 29180

Dated: September 27, 2007